

## REMARKS

The last Office Action dated 5/21/03 has been carefully considered. By this amendment, claims 1-2 were amended and claims 19-24 were added.

It is noted that **Claims 1, 3-7, 9-12** were rejected under 35 U.S.C. § 103 as being obvious by **Genest et al** (U.S. Pat. No. 6,480, 377) in view of Price et al (U.S. Pat. No. 6,377,444). Claims 2, 8, and 14 were objected to and would be allowed if rewritten in independent form. The examiners rejections are traversed below.

## AMENDMENTS

### 1. REGARDING CLAIMS 4, 10, and 16

The word **CRYSTALS** is misspelled. The correct interpretation of **LCD** is Liquid Crystal Display. Each claim was corrected accordingly.

### 2. REGARDING CLAIMS 1 AND 2

Per our telephone interview, in order to place claims 1-6 in a condition for allowance, the first two limitations of claim 2 was moved up into claim 1. The last two claim limitations remained in claim 2. This moved placed claims 1-6 in a condition for allowance. No amendments to the original claim limitations were made.

## ARGUMENTS

### 3. REGARDING ORIGINAL CLAIM 1

Genest discloses a latch and a hook to fasten the two portions of the handheld device together. Fastening means is normally defined as some type of structure that holds two separate structures together such as screw or latch and a hook. The applicant's claim invention discloses a hand support means for supporting the left and right hand while typing on the keypad. When the word "whereby" and its accompanying phrase set forth a structural limitation for the invention recited in the

claim, the word “whereby” and the accompanying phrase will be considered a positive limitation of the claim and thereby limit the claim accordingly. (See *Scheinman v Zalkind*, 112 F.2d 1017, 1019, 46 USPQ 141, 143 (C.C.P.A. 1940)). The Genest disclosed fastening means does not provide a structure to for hand support means. Your fingers are required to connect and dislodge the latch and hook. However, technically the fastener does not provide hand support. The applicant describes hand support means as a structure required to support the hands during typing. (See Page 8 Lines 23-29 and Page 9 Lines 1-5 in the specifications) The Genest disclosed fastening means is not structurally or functionally equivalent to the disclosed hand support means. Since the Genest disclosed fastening means is not an equivalent to the applicant’s disclosed hand support means structure in the specification, it cannot provide a suggestion or motivation to utilize Genest’s latch and hook as a hand support means and achieved the claimed invention. Therefore, in order to reclaim the original claims 1-6 based upon the argument above claims 19-24 are added.

#### **4. REGARDING CLAIM 7**

Genest discloses a handheld device with a first portion having a display screen operably connected onto its inner surface and a second portion having a keyboard operably connected onto its inner surface. The first and second portion are hingedly connected such that in an opened position the first and second portion are pivoted to lie adjacent to each other and in a closed position the inner surfaces of each portion are pivoted to face each other. A fastening means, a latch and hook, is disclosed which secures the first and second portion in a closed position.

The claimed invention describes a handheld device with the bottom surfaces of the first and second portion securely attached together. Hand support means are described to support the hands while typing on the keypad.

In order to establish a prima facie case of obviousness the resulting combination or modification must teach or suggest the claimed invention. (See *In re Wright*, 848 F. 2d 1216, 6 USPQ 2d 1959,1962 (Fed. Cir. 1988)). It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. The court

has previously stated that “one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” (See *In re Fritch*, 972 F. 2d 1260, 23 USPQ 2d 1780,1784 (Fed. Cir. 1992)). Here, Genest does not provide a suggestion or motivation to have multiple configurations to practice its disclosed invention. The Levengood decision teaches that an obvious rejection cannot be predicated on the fact that one skilled in the art would have the capabilities to arrive at the claimed invention. (See *Ex parte Levengood*, 28 USPQ 2d 1300, (Bd. Pat. App. & Inter. 1993)). The Lindell decision teaches that the Examiner may not use as an element of the obvious rejection that one skilled in the art would have arrived at the invention by trying different alternative structures. (See *In re Lindell*, 385 F. 2d 453, 155 USPQ 521 (C.C.P.A. 1967)). Here, Genest teaches pivoting the first and second portion between an opened and closed position. Genest does not teach or suggest an alternative configuration of affixing the bottom surfaces of the two portions together. Thus, one skilled in the art would have to provide the suggestion of an alternative configuration to obtain the applicant’s claimed invention. This argument is impermissible based upon the Levengood and Lindell decision.

The suggestion to combine the references must not require substantial reconstruction or design of the references to arrive at the claimed invention. (See *In re Ratti*, 270 F. 2d 810, 123 USPQ 349,1784 (C.C.P.A. 1959)). Here, Genest will have to be significantly redesigned and restructured to obtain the applicant’s claimed invention. Furthermore, the alternative configuration of the applicant’s claimed invention would render the Genest invention inoperable. It is not generally enough that the prior art suggest the combination recited in the claims; there must also be some reasonable expectation of success of the suggested combination. (See *In re Dow Chem. Co.* 837 F. 2d 469, 473 USPQ 2d 1529,1531 (Fed. Cir. 1988)).

Here, Genest teaches away from the applicant’s claimed invention. In Genest the first and second portion are pivoted into a closed position protecting the display screen and keypad. Then, the fastening means is utilized to secure the two portions in place and thereby protecting the display screen and keypad. With the applicant’s claimed invention the bottom surfaces are secured into an open position by affixing the two bottom surfaces.

Genest discloses a latch and a hook to fasten the two portions of the handheld device together. Fastening means is normally defined as some type of structure that holds two separate structures together such as screw or latch and a hook. The applicant's claim invention discloses a hand support means for supporting the left and right hands while typing on the keypad. When the word "whereby" and its accompanying phrase set forth a structural limitation for the invention recited in the claim, the word "whereby" and the accompanying phrase will be considered a positive limitation of the claim and thereby limit the claim accordingly. (See *Scheinman v Zalkind*, 112 F.2d 1017, 1019, 46 USPQ 141, 143 (C.C.P.A. 1940)). The Genest disclosed fastening means does not provide a structure to for hand support means. Your fingers are required to connect and dislodge the latch and hook. However, technically the fastener does not provide hand support. The applicant describes hand support means as a structure required to support the hands during typing. (See Page 8 Lines 23-29 and Page 9 Lines 1-5 in the specifications) The Genest disclosed fastening means is not structurally or functionally equivalent to the disclosed hand support means in the specification. (See 35 USC §112 paragraph 6) Since the Genest disclosed fastening means is not an equivalent to the applicant's disclosed hand support means structure in the specification, it cannot provide a suggestion or motivation to utilize Genest's latch and hook as a hand support means and achieve the claimed invention.

##### **5. REGARDING CLAIM 13**

Genest discloses a handheld device with a first portion having a display screen operably connected onto its inner surface and a second portion having a keyboard operably connected onto its inner surface. The first and second portion are hingedly connected such that in an opened position the first and second portion are pivoted to lie adjacent to each other and in a closed position the inner surfaces of each portion are pivoted to face each other. A fastening means, a latch and hook, is disclosed which secures the first and second portion in a closed position. Allgeyer discloses sliding members attached to a disk. Allgeyer does not teach or suggest in a broad sense utilizing guide members on a handheld computer device.

The claimed invention describes a handheld device with a pair of sliding guide members attached to each side edge of the first and second portion. The pair of guide members is utilized to secure the bottom surfaces of the first and second portion in a parallel position. Hand support means are described to support the hands while typing on the keypad.

In order to establish a prima facie case of obviousness the resulting combination or modification must teach or suggest the claimed invention. (See *In re Wright*, 848 F. 2d 1216, 6 USPQ 2d 1959,1962 (Fed. Cir. 1988)). It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. (See *In re Fritch*, 972 F. 2d 1260, 23 USPQ 2d 1780,1784 (Fed. Cir. 1992)). Here, Genest does not provide a suggestion or motivation to have multiple configurations to practice its disclosed invention. The Levengood decision teaches that an obvious rejection cannot be predicated on the fact that one skilled in the art would have the capabilities to arrive at the claimed invention. (See *Ex parte Levengood*, 28 USPQ 2d 1300, (Bd. Pat. App. & Inter. 1993)). The Lindell decision teaches that the Examiner may not use as an element of the obvious rejection that one skilled in the art would have arrived at the invention by trying different alternative structures. (See *In re Lindell*, 385 F. 2d 453, 155 USPQ 521 (C.C.P.A. 1967)). Here, Genest teaches pivoting the first and second portion between an opened and closed position. Genest does not teach or suggest an alternative configuration utilizing guide members to secure the bottom surfaces of the two portions together. Thus, one skilled in the art would have to provide the suggestion of an alternative configuration to obtain the applicant’s claimed invention. This argument is impermissible based upon the Levengood and Lindell decision.

The suggestion to combine the references must not require substantial reconstruction or design of the references to arrive at the claimed invention. (See *In re Ratti*, 270 F. 2d 810, 123 USPQ 349, 1784 (C.C.P.A. 1959)). Here, Genest will

have to be significantly redesigned and restructured to obtain the applicant's claimed invention.

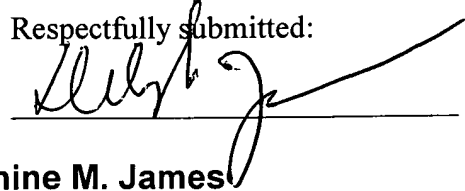
Here, Genest teaches away from the applicant's claimed invention. In Genest, the first and second portions are pivoted into a closed position protecting the display screen and keypad. Then, the fastening means is utilized to secure the two portions in place and thereby protecting the display screen and keypad. With the applicant's claimed invention, the bottom surfaces are secured into an open position by guide members attached to the side edges of each portion of the handheld device.

Genest discloses a latch and a hook to fasten the two portions of the handheld device together. Fastening means is normally defined as some type of structure that holds two separate structures together such as screw or latch and a hook. The applicant's claim invention discloses a hand support means for supporting the left and right hand while typing on the keypad. When the word "whereby" and its accompanying phrase set forth a structural limitation for the invention recited in the claim, the word "whereby" and the accompanying phrase will be considered a positive limitation of the claim and thereby limit the claim accordingly. (See *Scheinman v Zalkind*, 112 F.2d 1017, 1019, 46 USPQ 141, 143 (C.C.P.A 1940)). The Genest disclosed fastening means does not provide a structure to for hand support means. Your fingers are required to connect and dislodge the latch and hook. However, technically the fastener does not provide hand support. The applicant describes hand support means as a structure required to support the hands during typing. (See Page 8 Lines 23-29 and Page 9 Lines 1-5 in the specifications) The Genest disclosed fastening means is not structurally or functionally equivalent to the disclosed hand support means. Since the Genest disclosed fastening means is not an equivalent to the applicant's disclosed hand support means structure in the specification, it cannot provide a suggestion or motivation to utilize Genest's latch and hook as a hand support means and achieved the claimed invention.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would

facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned.

Respectfully submitted:



**Delphine M. James**

**Registration No. 45,960**

**Delphine James, Attorney At Law**

**2656 South Loop West #170**

**Houston, Texas 77054**

**(713) 661-4144**

**(713) 661-4145 (FAX)**

#### **CERTIFICATE OF MAILING**

I, **Delphine James**, hereby certify that the foregoing **Amendment** is being deposited on 08/20/03 with the United States Postal Service as U.S. Mail, Express mail, in an envelope addressed to:

Commissioner of Patents

Patent Application

Washington DC 20231

Additionally, the foregoing Amendment is being faxed to 703-872-9314.

Express Mail Receipt No. ER065958041 US.

By: 